

REMARKS

At Paragraph No. 1 of the Action, claims 1-3 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Catena (U.S. Patent No. 5,256,450) in view of Reich (U.S. Patent No. 5,350,783).

In response, Applicant respectfully traverses for the following reasons.

First, there is no sufficient teaching, suggestion, motivation, or other reason to combine Catena with Reich. On page 5, the Office Action states that no express motivation is required to substitute equivalent additives as long as the prior art recognizes equivalency. However, the prior art does not recognize Na as equivalent to Ca and Mg for every purpose. A person of ordinary skill in the art would have recognized that Na is an alkali metal that typically carries a single positive charge, whereas Ca and Mg are alkaline earth metals that typically carry a double positive charge. This same general argument applies to the rest of the recited non-alkali metals of claim 3 or the non-alkali metals recited by Reich. See column 4, lines 63-68 and column 6, lines 27-33 of Reich.

For example, the Office Action cites *Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co.* as holding that ions are interchangeable for the purpose of an obviousness rejection when recognized by the art as such. 85 USPQ 328 (US 1950). However, the *Graver Tank* Court found two ions (Mg and Mn) equivalent, for purposes of the doctrine of equivalents, *for a welding composition*. *Id.* at 330. The Supreme Court's reasoning was based on disclosures in the prior art and expert testimony stating that Mg and Mn were generally interchangeable in a silicate as a

component of a welding composition. *Id.* at 331. In other words, Mg and Mn were equally suitable in an otherwise identical composition used *for the same purpose*.

Although Reich may acknowledge that Mg, Ca, K, and Na are equivalent for Reich's purpose, Reich seems to do so only as a non-oxidizing, place-holder ion for EDTA. For example, a person having ordinary skill in the art would have recognized that any positively charged ion might complex with EDTA, and that any less oxidizing metal might displace the non-oxidizing metals in Reich's system. Thus, Na may be equivalent to Ti, Mg, and Ca in Reich's context, but only in the sense that they are positively charged and less oxidizing than the "oxidizing metals" Reich recommends. Therefore, the equivalence Reich suggests is not applicable to Applicant's disclosure, where a non-alkali metal is activated to act as an accelerant for polymerization. Thus, there is no motivation for substituting the Ti, Ca, or Mg EDTA complex of Reich with the Na EDTA of Catena.

Moreover, the instant specification maintains that Ti, Mg, and Ca are not interchangeable with Na, as do the claims. Reich also acknowledges that Fe, Cu, Mg, Co, Cr, Ni, V, and Zn are not equivalent to Na, because Reich lists the former as oxidizing metals and the latter as a non-oxidizing metal. See column 6, lines 27-33 of Reich. Therefore, there is no proper teaching, suggestion, motivation, or other reason to substitute the Fe, Cu, Mg, Co, Cr, Ni, V, or Zn complexes of Reich into the Na EDTA of Catena.

Second, a person of ordinary skill in the art would not have combined Catena with Reich, because the teachings of Catena and Reich discourage such a combination. Catena is directed toward a sealant with good heat resistance and low shrinkage for porous materials, such as metal. See column 1, lines 10-16 of Catena. Reich is directed toward a composting agent that uses

EDTA as a complexing agent to release “active oxidants which degrade the polymer to a low molecular weight biodegradable material.” See Abstract and column 6, lines 54-56 of Reich. A person of ordinary skill in the art would not have combined Reich’s teachings for forming a biodegradable polymer with Catena’s teaching to make a sealant with good heat resistance and low shrinkage, because a person of ordinary skill in the art would not be motivated to produce a *biodegradable sealant*. Therefore, Reich’s teachings regarding metal complexes would discourage combination with Catena to reach the presently claimed invention.

Moreover, Reich mentions that metal complexes act as a biodegradation promoter for biodegradable plastics. In these examples, Mg, Ca, Na, and K are mentioned as a metal and, as a ligand, diethyldithiocarbamate, hydroxyethylethylenediaminetriacetic acid and the like are mentioned along with EDTA and DTPA. See column 5, lines 2-3 of Reich.

On the other hand, the presently claimed invention relates to an anaerobic curable composition. See the Abstract of the present Application. Also, as disclosed in the present specification, most of the anaerobic curable compositions achieving curing acceleration lower preservability. See the second paragraph of the Background section of the present specification. Therefore, selection of a specific curing accelerator to avoid lowering preservability from a list of possibilities is **not** easy.

As described above, although Reich exemplifies various complexes, these are biodegradation promoters (accelerators), which are completely different from curing accelerators for the anaerobic curable composition disclosed and claimed in the present application. In addition, as described above, Reich mentions many complexes in addition to EDTA and DTPA, which indicates that such complexes may be used equivalently for Reich’s purpose. Since Reich does not show a more specific motivation, it is **not obvious** to substitute the EDTA complexes of

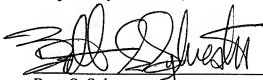
Reich with the NaEDTA of Catena. Therefore, there is no proper motivation to combine Reich with Catena.

The anaerobic curable composition of the present invention is patentable over Catena and Reich. Reconsideration and withdrawal of the § 103 rejection based on Catena and Reich are respectfully requested.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brett S. Sylvester", written over a horizontal line.

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